

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 432383-600068

Group Art Unit:	3692)	
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Examiner:	S. Meinecke Diaz)	
)	
Inventor(s):	David K. Gifford)	
)	REQUEST FOR
Serial No.:	09/711,511)	REHEARING
)	
Filed:	November 14, 2000)	
)	
For:	Digital Active Advertising)	
)	

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This request for rehearing is submitted in response to the Board's decision dated September 11, 2009. Any fees due should be charged to Jones Day Deposit Account No. 501432, ref: 432383-600068. Appellant respectfully submits that the § 112 indefiniteness rejection newly raised by the Board is in error for at least the reasons set forth below.

The Board's New Indefiniteness Rejection For The Means-Plus-Function Claim Elements Is In Error Because The Specification Clearly Discloses Proper Structure In The Form Of An Algorithm (E.G., Responding To User Activation Of Hyperlinks, HTTP Formatted Requests, Etc.).

The Board's decision based its indefiniteness rejection by analyzing a particular means-plus-function limitation of claim 4. Accordingly, appellant focuses herein upon

the decision's analysis of this claim limitation. This limitation of claim 4 reads: "*purchase means responsive to a user request for communicating a purchase message to a merchant computer.*"

The Board's decision properly cites to *Golight* in delineating the two-step process for construing this means-plus-function limitation of claim 4:

The first step in construing a means-plus-function claim limitation is to define the particular function of the claim limitation. *Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1376 (Fed. Cir. 2001). "The court must construe the function of a means-plus-function limitation to include the limitations contained in the claim language, and only those limitations." *Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 296 F.3d 1106, 1113 (Fed. Cir. 2002). Thus, according to the language of claim 11, the function of the "horizontal drive means" is "rotating said lamp unit in a horizontal direction." Ordinary principles of claim construction govern interpretation of this claim language, *see id.*, and, for all the reasons discussed in the preceding two sections, we construe this function according to its ordinary meaning as not requiring rotation through 360°.

The next step in construing a means-plus-function claim limitation is to look to the specification and identify the corresponding structure for that function. "Under this second step, structure disclosed in the specification is "corresponding" structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim.'" *Med Instrumentation & Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1210 (Fed. Cir. 2003) (quoting *B. Braun Med Inc. v. Abbott Labs.*, 124 F.3d 1419, 1424 (Fed. Cir. 1997)).

(*See*, page 9 of the Board's decision, citing to *Golight Inc. v. Wal-Mart Stores Inc.*, 355 F.3d 1327, 1333-34 (Fed. Cir. 2004).)

Using the above case precedent, the decision construed the function of this limitation as: "[*purchasing via*] respon[ding] to a user request for communicating a purchase message to a merchant computer." After the Board identified the function of

the limitation, the Board then looked to the specification and identified the corresponding structure for that function. (*See, Golight Inc.* at 1333-1334.) As noted in *Finisar*, the corresponding disclosure specification can take many different forms:

[T]he patent must disclose, at least to the satisfaction of one or ordinary skill in the art, enough of an algorithm to provide the necessary structure under § 112, ¶6. This court permits a patentee to ***express that algorithm in any understandable terms including as a mathematical formula, in prose, see In re Freeman, 573 F.2d 1237, 1245-46 (CCPA 1978), or as a flow chart, or in any other manner that provides sufficient structure.***

Finisar Corp. v. DirecTV Group, Inc., 523 F.3d 1323, 1340-41 (Fed. Cir. 2008)

(emphasis added).

The board correctly looked at the disclosure on page 13, line 13 to page 14, line 8 as well as FIG. 6 of appellant's specification for proper structural support for the purchase means limitation. These portions of the specification are reproduced below for convenience.

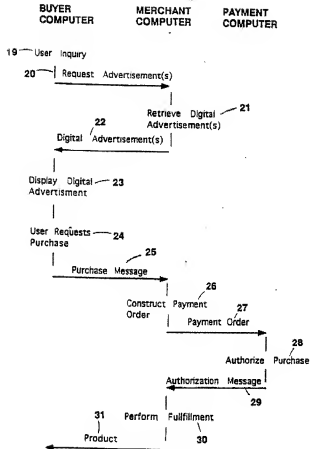


FIG. 6

Figure 6 is a flowchart that more fully describes the information flow in the purchase transaction shown in Figures 2 to 5. An initial user inquiry 19 from activating link 1 results in the HTTP request 20 for a specific document with a specified URL. The URL specifies the name of the merchant computer. The merchant computer retrieves the document given the URL at 21, and returns it to the buyer computer at 22. The buyer computer displays the resulting HTML, document at 23. **When the user activates link 5, an HTTP request 25 is sent to the merchant computer requesting the document.**

In an alternate embodiment, document 22 is executed at 23 as a program. A program is defined as a set of instructions that can exhibit conditional behavior based upon user actions or the environment of the buyer computer. As is known to those skilled in the art, there are many techniques for representing programs as data. The program can be interpreted or it can be directly executed by the buyer

computer. The program when executed will cause the buyer computer to interact with the user leading to the user purchase request 24, and the purchase message 25. (emphasis added)

FIG. 6 (at reference number 25) and page 13, lines 21-23, highlighted above, clearly identify as proper structure an algorithm corresponding to the function of “[purchasing via] respon[ding] to a user request for communicating a purchase message to a merchant computer” in a combination of a flowchart and prose, which forms are expressly authorized by *Finisar*. The algorithm disclosed in these portions of the specification involves responding to a specific type of user communication mechanism, that is a hyperlink on a user’s displayed web document, and formatting the message according to a specific type of protocol, that is HTTP, as well as specifying that the content of the message is created to request a specific document: “When a user activates link 5, an HTTP request 25 is sent to the merchant computer requesting the document.”

In other words, the disclosed algorithm which corresponds to the function at issue is very specific: hyperlinks having specific URLs are activated and are responded to, the communication message is formatted according to the HTTP protocol, the algorithm creates the message with specific content for requesting a specific document, etc. None of these technical features are recited in the limitation at issue. Accordingly, the Board’s conclusion on page 12 of the decision that “the Specification repeats, in different words, the function at issue” is incorrect.

In short, because the specification includes proper recitation of a structure and algorithm for the purchase means limitation, it is respectfully submitted that the scope of the limitation can be properly construed. Because the scope of the purchase means limitation can be properly determined, it is respectfully submitted that the newly raised

§ 112 rejection of the claims be withdrawn. Additionally, it is respectfully submitted that the other means-plus-function limitations are similarly supported by the flowcharts of FIGS. 6 and 7 and the associated description and throughout the specification.

Because the claims are not indefinite, it is respectfully submitted that the substance of the § 103 rejections briefed previously by the appellant and the examiner is ripe for addressing. Thus, the Board should withdraw the § 112 rejections of the claims and explicitly overturn the § 103 rejections based on their insufficiency in making a *prima facie* case for obviousness.

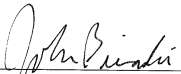
Appellant respectfully submits that a decision from the Board regarding the § 103 rejection is *necessary* to bring the nine year prosecution of this application to an expedient conclusion. By not providing a substantive ruling on the § 103 rejections, the decision provides the very real possibility for the examiner to continue to reject improperly the pending claims based on the Bush and Alantec references.

CONCLUSION

For the aforementioned reasons, appellant respectfully submits that the newly raised § 112 rejections are in error. Appellant also submits that the § 103 rejections raised by the Examiner are in error based on their merits, as detailed in the appellant's previously filed briefs. Accordingly, appellant respectfully submits that the pending claims are allowable and requests reconsideration of the claims at issue.

Respectfully submitted,

Dated: November 11, 2009

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